

REMARKS

Claims 20 - 28 are pending in the application. Claims 1 – 19 and 29 - 31 have been cancelled. Claims 20 - 28 have been amended. New claim 32 has been added.

Any cancellation of the claims should in no way be construed as acquiescence to any of the Examiner's rejections and was done solely to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Claim Rejections- 35 U.S.C. §102

Claims 20 - 28 stand rejected under 35 U.S.C. §102(e) as being anticipated by Lorenz (US 6,706,867; the '867 reference herein). (Office Action, p.2). Applicants respectfully traverse the rejection.

Claim 20 as amended recites a microarray for distinguishing a neuroendocrine tumor cell, said microarray comprising a solid support and a sufficient number of genes, or polynucleotide fragments or RNA transcripts thereof, that are differentially expressed in a small cell lung cancer (SCLC) cell, a large cell neuroendocrine carcinoma (LCNEC) neuroendocrine tumor cell, a typical carcinoid (TC) neuroendocrine tumor cell, or an atypical carcinoid (AC) neuroendocrine tumor cell, relative to a normal cell or a cell belonging to a different neuroendocrine tumor cell type, to permit said microarray to distinguish a neuroendocrine tumor cell, and wherein said genes or polynucleotide fragments or RNA transcripts thereof consists of CPE and GGH, or a polynucleotide fragment or RNA transcript thereof.

To anticipate a claim, each and every element of the claim must be found in a single reference. This is discussed in the Manual of Patent Examining Procedure § 2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The '867 reference does not teach or suggest all the limitations of the instant claims. In particular, the '867 reference does not teach or suggest a microarray of genes, or polynucleotide fragments or RNA transcripts for distinguishing a neuroendocrine tumor cell, as instantly claimed, and where the genes or polynucleotide fragments or RNA transcripts consist of CPE and GGH, or a polynucleotide fragment or RNA transcript thereof.

The Examiner argues that the '867 reference "discloses a microarray compris(ing) representative clones for more than 13,389 immunological clusters, wherein GGH, COMT and CPE are among the selected genes (and) although the chip disclosed in (the '867 reference) is not used to identify genes differentially expressed in different types of neuroendocrine tumor, it nevertheless meets the limitation of a microarray compris(ing) genes distinguishably arrayed in spaced apart regions and comprises more than 10 genes, wherein said genes or transcripts include GGH, COMT, and CPE." (Office Action, p.3).

The '867 reference provides DNA arrays useful for diagnostic procedures and in particular for screening methods involving immunologically based sample materials. (column 16, lines 13 – 16). As pointed out by the Examiner, at col. 3, the '867 reference teaches that "the array is a unique cDNA microarray specifically designed for immunology research. In a particularly preferred embodiment, (the) microarray...was constructed in two

steps. First, immunological relevant clusters were selected using literature and expression information. Second, the best representative clones for each of the selected clusters were identified. The array comprised representative clones for more than 13,389 different immunological clusters (**Table 1**).” (col. 3, lines 1 – 10). The Examiner argues that GGH, COMT and CPE **are among** the selected genes in Table 1, that lists more than 13,000 genes.

Nowhere does the ‘867 reference teach or suggest a microarray of genes **consisting of CPE and GGH**, or a polynucleotide fragment or RNA transcript thereof, as claimed.

Accordingly, Applicants respectfully request that the foregoing rejection be withdrawn.

CONCLUSION

For the reasons provided, Applicant submits that all claims are allowable as written and respectfully requests early favorable action by the Examiner. If the Examiner believes that a telephone conversation with Applicant's attorney/agent would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney of record.

It is believed no additional fees are due, however should any fee be due, the Commissioner is authorized to charge such fee to our Deposit Account, No. 04-1105, Reference 63139(47992). Any overpayment should be credited to said Deposit Account.

Respectfully submitted,

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